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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/422,838	10/22/1999	CHUAN-FA LIU	01017/36263	6047

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EXAMINER

BORIN, MICHAEL L

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 12/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

09/422,838

Applicant(s)

LIU ET AL.

Examiner

Michael Borin

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 10 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 1,3-23,25,26 and 28-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 27 is/are rejected.
- 7) ☒ Claim(s) 7,16 and 24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

Claims 1-34 are pending. Claims 17-23,25,26,28-34 remain withdrawn from consideration as drawn to non-elected groups of inventions, and claims 3-6,8-15 remain withdrawn from consideration as drawn to non-elected species.

As stated in the previous Office action, the elected species, SEQ ID No. 34, as well as subject matter of claims 7,16,24, had been found to be free of prior art. Consequently, Examiner has extended his search to a reasonable number of additional species encompassed by claim 1,2. Claims 1,2,27 were rejected under 35 U.S.C. 102(e) as anticipated by Dower et al. (US Patent 6,251,864). Applicant argues that the priority document for US Patent 6,251,864, application 08/699027, did not contain information on dimers used in the rejection. Examiner found the argument convincing; in response the reference is replaced by another patent of Dower et al. Claims 3-6,8-15 remain withdrawn from consideration as drawn to non-elected species.

### ***Claim Rejections - 35 USC § 102.***

The following is a quotation of the appropriate paragraphs of 35 U.S.C.102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claims 1,2,27 are rejected under 35 U.S.C. 102(e) as anticipated by Dower et al. (US Patent 5,869,451; filed 12/11/1996).

Dower et al. teach peptide binding to thrombopoietin receptor and compositions thereof. The peptides are preferably dimerized, to increase affinity and/or activity of compounds. In particular, the reference teaches dimer



which is a dimer comprising sequence ADGPTLREWI which reads on the structure X2-X10 of TMP identified in claims 1,2. See table 13, compound SEQ ID 231. The referenced dimers read on the dimers generally described in claim 1, and more specifically identified in claim 2, wherein X1=Ala, X11=Ser, X12=Phe.

It is the Examiners position that all the elements of Applicant's invention with respect to the specified claims are instantly disclosed by the teaching of the reference.

### ***Conclusion.***

Claims 7,16,24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 7,16,24 are novel and unobvious over the prior art of record or any combination thereof. The prior art of record does not teach or suggest dimers of SEQ ID No. 1 connected from C-terminus of one monomer to N-terminus of the other. US Patent 6,251,864, as well as other patents of the inventors of the referenced patent, teach dimers of the instantly claimed SEQ ID No. 1 connected head-to-head with their C-terminals. See, e.g., US Patent 6,251,864, col. 6,13,56.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Borin whose telephone number is (703) 305-4506. Dr. Borin can normally be reached between the hours of 8:30 A.M. to 5:00 P.M. EST Monday to

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Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Michael Woodward, can be reached on (703) 308-4028. The fax telephone number for this group is (703) 305-3014.

Any inquiry of a general nature or relating the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

12/2/03  
mlb

MICHAEL BORIN, PH.D  
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'Michael Borin', is written below the printed name and title.